

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Sung-hee HWANG et al.

Serial No. 10/800,871

Group Art Unit: 2627

Confirmation No. 1566

Filed: March 16, 2004

Examiner: Jorge L. Ortiz Criado

For: RECORDING METHOD, RECORDING APPARATUS, OPTICAL RECORDING MEDIUM
AND COMPUTER READABLE RECORDING MEDIUM STORING THE RECORDING
METHOD

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed June 15, 2007, having a shortened period for response set to expire on July 15, 2007, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **claims 1-22** in response to the preliminary restriction requirement set forth in the Office Action and identify claims reading on the species as follows:

FIG. 4 claims 1-22

FIG. 8 claims 23-30

II. Applicants Traverse the Requirement

Insofar as the species directed towards FIG. 8 is concerned, it is believed that claims 23-30 are so closely related to elected claims 1-22 that they should remain in the same application. The elected claims 1-22 are directed to recording methods of recording temporary defect information (claims 1-3 and 4-7), recording apparatuses to record temporary defect information (claims 8-10 and claims 11-14), optical recording media having temporary defect information recorded thereon (claims 15-17 and 18-21), and a computer-readable medium having embodied thereon a computer program executing a recording method to store temporary defect information

(claim 22) and claims 23-30 are drawn to a method of accumulating and recording temporary defect information (claims 23-29) and a computer-readable medium having embodied thereon a computer program executing a recording method to accumulate and record temporary defect information (claim 30). There have been no references cited to show any necessity for requiring restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the FIG. 8 species claims by filing a divisional application.

It is further noted that the Examiner has based the reason for restriction on a mere statement of conclusion. MPEP §808.01 states: "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate." Here, the Examiner states: "in the instant case, species a and b are materially different in embodiment designs as described having different modes of operations, functions and effects of the method and apparatus for recording the optical recording medium, which are not an obvious variant of species." However, the Examiner has not explained how the two species have "different modes of operations, functions and effects." For this reason as well, it is respectfully submitted that the restriction requirement should be withdrawn.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers claims 1-22 to be a separate invention from claims 23-30, the Applicants respectfully request the Examiner to consider claims 1-22 (species directed towards FIG. 4) and claims 23-30 (species directed towards FIG. 8) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that claims 23-30 are drawn to a method of accumulating and recording temporary defect information (claims 23-29) and a computer-readable medium having embodied thereon a computer program executing a recording method to accumulate and record temporary defect information (claim 30),

and elected claims 1-22 are directed to recording methods of recording temporary defect information (claims 1-3 and 4-7), recording apparatuses to record temporary defect information (claims 8-10 and claims 11-14), optical recording media having temporary defect information recorded thereon (claims 15-17 and 18-21), and a computer-readable medium having embodied thereon a computer program executing a recording method to store temporary defect information (claim 22), and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 503333.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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Date: 4/13/07

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